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## REMARKS

### Status of Claims

#### Current Status

Claims 1-4, 8-51, and 55-65 are pending. Claims 1-4, 8-51, and 55-65 are rejected.

Applicants gratefully acknowledge the Examiner's favorable reconsideration and withdrawal of the previous 35 U.S.C. §102(b) rejection of claims 1-4, 32, 33, 36, 37, 39, 41-44, 47, 48, 51, and 58 over Grebow et al., the previous 35 U.S.C. §102(b) rejection of claims 2, 36, 37, and 39 over Nguyen et al., the previous 35 U.S.C. §103(a) rejection of claims 17, 18, 34, 35, 38, 45, 46, 49, and 50 over Grebow et al., and the Examiner's acknowledgement that the property limitation of claim 1 is to be accorded patentable weight.

#### Present Reply

In this reply, claims 1, 3, 4, 8-38, 41, 42, 44-50, 55, 57-59, 61, and 63-65 are amended. Claims 2, 51, and 62 are canceled. Claims 66-68 are new.

Independent claims 1 and 36 and claims dependent thereon are amended to recite that the particle-forming composition is a solution (liquid or solid). Support for these amendments can be found on page 4, lines 18-19 and Examples 1-7.

Claims 41 and 42 are redrafted in independent format.

Support for new claim 66 can be found on page 6, line 16. Support for new claims 67 and 68 can be found on page 4, lines 18-19 and Examples 1-7.

Upon entry of the present amendments, claims 1, 3, 4, 8-50, 55-61, and 63-68 will be pending in this application.

No new matter has been added by way of these amendments.

### Claim Rejections

Reconsideration and allowance of all claims is hereby respectfully requested in light of the following discussion.

#### Rejection under 35 U.S.C. §102

*Nguyen:*

Claims 1, 3, 4, 11, 14, 15, 32, 33, 47, and 51 are rejected under 35 U.S.C. §102(b) as being anticipated by Nguyen et al. (US 5,843,347). The Examiner alleges that

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the Nguyen composition meets the limitations of the claimed composition and would inherently possess the claimed characteristic of spontaneously forming an aqueous liquid homogeneous composition of non-crystalline particles when contacted with an aqueous medium.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (MPEP §2131).

Non-Aqueous Liquid Solution

Applicants have now amended the claims to recite a non-aqueous solution (liquid or solid). Nguyen does not disclose each and every element of the rejected claims because Nguyen does not disclose a non-aqueous liquid solution. Nguyen discloses a pasty mixture containing (a) a polymer component with a molecular weight greater than or equal to 10,000 daltons, which swells in the presence of water, (b) a water-soluble or water-dispersible component, (c) an active ingredient such as modafinil, which is insoluble in water (<1 mg/mL), and (d) water (col. 4, line 64 – col. 5, line 9 and col. 6, lines 1-5). Given that the Nguyen composition is a pasty mixture containing water and insoluble modafinil, it is not a non-aqueous liquid solution because (1) it is aqueous, and (2) it is not a solution.

Non-Aqueous Solid Solution

Nguyen also does not disclose a non-aqueous solid solution. Nguyen discloses microbead particles obtained by lyophilizing the aqueous pasty mixture containing insoluble modafinil (col. 4, line 64 – col. 5, line 15; and Examples 16-17). Those of ordinary skill in the art are aware that solid solutions are prepared from liquid solutions. Given that the Nguyen microbead particles are prepared from a pasty mixture containing insoluble modafinil – i.e., not a liquid solution – the resulting microbead particles are not a solid solution.

In view of the fact that Nguyen fails to disclose a non-aqueous liquid or solid solution, Nguyen is not an anticipatory reference. Applicants respectfully request that this rejection be withdrawn.

Rejections under 35 U.S.C. §103

*Nguyen in view of Lafon:*

Claims 8-10, 12, 13, 16-31, 34, 35, 38, 40-46, 60, and 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nguyen et al. (US 5,843,347) in view of Lafon (US

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5,180,745).

To establish a *prima facie* case of obviousness, the Examiner must demonstrate that a prior art reference teaches or suggests all of the limitations of the rejected claims (MPEP § 2142).

The rejected claims have been amended to recite a non-aqueous solution (liquid or solid). As discussed above, Nguyen fails to teach a non-aqueous liquid or solid solution. Nguyen also fails to suggest a non-aqueous liquid or solid solution.

#### Non-Aqueous Liquid Solution

Nguyen is concerned with microbead particles prepared by lyophilization of an aqueous pasty mixture. There is no motivation to modify Nguyen's *aqueous* pasty mixture to form a *non-aqueous* liquid solution, because such a modification would require a fundamental departure from the teaching of the reference – Nguyen teaches lyophilization and lyophilization requires water (col. 2, lines 24-26). Lafon cannot cure the deficiencies of Nguyen because Lafon is relied upon for a disclosure that modafinil is used to treat Parkinson's disease.

#### Non-Aqueous Solid Solution

The aqueous pasty mixture of Nguyen contains insoluble modafinil (solubility <1 mg/mL) (col. 14, Examples 16-17). There is no motivation to modify the aqueous pasty mixture containing *insoluble* modafinil to form an aqueous pasty mixture containing *dissolved* modafinil because a solution is not required to prepare the lyophilized Nguyen microbead particles (col. 8, lines 23-24; col. 14, Examples 16-17). And even if a person of ordinary skill was motivated to prepare an aqueous pasty mixture containing *dissolved* modafinil, Nguyen contains no disclosure of how to prepare such a mixture, given modafinil's extremely low water solubility (i.e., <1 mg/mL). Because there is no suggestion to prepare an aqueous pasty mixture containing *dissolved* modafinil, there is no suggestion in Nguyen to prepare a solid solution by lyophilizing such a mixture. Accordingly, Nguyen fails to suggest a solid solution. Lafon cannot cure the deficiencies of Nguyen because Lafon is relied upon for a disclosure that modafinil is used to treat Parkinson's disease.

In view of the fact that Nguyen, alone or in combination with Lafon, fails to teach or suggest a non-aqueous liquid or solid solution, Nguyen and Lafon do not teach or suggest each limitation of the rejected claims and therefore cannot render the rejected claims obvious. Applicants respectfully request that this rejection be withdrawn.

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**Nguyen and Grebow:**

Claims 2, 36-39, 48-50 and 55-58 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nguyen et al. (US 5,843,347) in view of Grebow (US 5,618,845).

To establish a *prima facie* case of obviousness, the Examiner must demonstrate that a prior art reference teaches or suggests all of the limitations of the rejected claims (MPEP § 2142).

Claim 2 has been canceled. Claims 36-39, 48-50 and 55-58 have been amended to recite a non-aqueous solution (liquid or solid). As discussed above, Nguyen does not teach or suggest a non-aqueous solution.

Grebow also fails to teach or suggest a non-aqueous solution. The Grebow reference is concerned with solid particles, not solutions. Specifically, the Grebow reference is directed to a pharmaceutical composition comprising solid modafinil particles having a defined particle size (col. 2, lines 6-8). The Grebow invention is based on the discovery that the size of a solid modafinil particle is important to the potency and safety of the drug (col. 2, lines 8-10). According to the Grebow disclosure, the preferred mean particle size of a solid modafinil particle is from about 2 microns to about 19 microns (col. 2, lines 51-53), the preferred median particle size of a solid modafinil particle is from about 2-60 microns (col. 2, lines 56-58), and the preferred mode particle size of a solid modafinil particle is from about 2-60 microns (col. 2, lines 61-63). Grebow states that the solid modafinil particles having a defined particle size can be present in a pharmaceutical composition, which may be a tablet, capsule, powder, pill, liquid/suspension or emulsion (col. 4, lines 12-18 & col. 10, lines 18-21). Importantly, each of these pharmaceutical compositions contains solid modafinil particles of a defined particle size. There is no motivation to modify the Grebow disclosure to form a modafinil solution because such a modification would dissolve and thus destroy the solid modafinil particles of defined particle size, which form the basis of the Grebow invention (col. 4, lines 53-55). Modifying Grebow to dissolve the solid modafinil particles of defined particle size would require a fundamental departure from the teaching of the reference. Accordingly, Grebow does not teach or suggest a non-aqueous liquid or solid solution.

In view of the fact that Nguyen and Grebow fail to teach or suggest a non-aqueous solution, Nguyen and Grebow do not teach or suggest each limitation of the rejected claims and therefore cannot render the rejected claims obvious. Applicants respectfully request that this

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rejection be withdrawn.

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*Nguyen and Grebow in view of Lafon:*

Claims 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (US 5,843,347) and Grebow et al. (US 5,618,845) in view of Lafon (US 4,927,855).

To establish a *prima facie* case of obviousness, the Examiner must demonstrate that a prior art reference teaches or suggests all of the limitations of the rejected claims (MPEP § 2142).

The rejected claims have been amended to recite a non-aqueous solution (liquid or solid). As discussed above, Nguyen and Grebow fail to teach or suggest a non-aqueous solution. Lafon fails to cure the deficiencies of Nguyen and Grebow because Lafon is relied upon for a disclosure that the levorotatory form of modafinil is useful in the treatment of Alzheimer's disease.

In view of the fact that Nguyen and Grebow, alone or in combination with Lafon, fail to teach or suggest a non-aqueous solution, Nguyen, Grebow and Lafon do not teach or suggest each limitation of the rejected claims and therefore cannot render the rejected claims obvious. Applicants respectfully request that this rejection be withdrawn.

**Rejections under 35 U.S.C. §112**

Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that it is unclear what the units of molecular weight are.

In order to expedite the prosecution and without agreeing to the merits of the rejection, Applicants have now amended claim 59 to recite "daltons" as the unit of molecular weight. In view of this amendment, Applicants respectfully request that this rejection be withdrawn.


**Conclusion**

Applicants respectfully submit that each rejection has been addressed. It is believed that all the claims are in form for allowance, and an early notification to that end is respectfully requested. Applicants invite the Examiner to contact the undersigned at (610) 883-5679 to clarify any remaining issues.

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Respectfully submitted,

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